APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,325	07/22/2003	Wealthy Desai	9400-34	7298

39072 7590 08/14/2007	**EXAMINER**
MYERS BIGEL SIBLEY & SAJOVEC, P.A. P.O. BOX 37428 RALEIGH, NC 27627	LEVINE, ADAM L

ART UNIT	PAPER NUMBER
3625	

MAIL DATE	DELIVERY MODE
08/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/624,325	DESAI, WEALTHY
	Examiner	Art Unit	
	Adam Levine	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2007*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,6-16,19-30,32,34-44,47-58,60,62-72 and 75-85* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,6-16,19-30,32,34-44,47-58,60,62-72 and 75-85* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant filed amendments and remarks on May 10, 2007, in response to the

office action dated November 13, 2006. In this response, applicant has amended

claims 1,29, and 57. Including claims previously cancelled, applicant has now cancelled

claims 3,5,17-18,31,33,45-46,59,61, and 73-74. Claims 1-2,4,6-16,19-30,32,34-44,47-

58,60,62-72, and 75-85 are pending and examined in this office action. Applicant's

claim listing is non-compliant because claim 57 is identified as "Previously presented"

although it is clearly "Currently amended." The legal instruments examiner did not

notice the non-compliance, and the examiner has chosen to disregard it and proceed

with examination because the amendment is clear and reflects similar amendments in

the other independent claims.

Response to Arguments

Applicant's arguments with respect to claims 1,16,29, and 57 have been fully

considered but they are not persuasive.

Pertaining to rejection of claims 1,29, and 57

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). Applicant argues that elements are not present in the prior art by citing specific

examples of the disclosure in Superpages, but the elements at issue were cited in the

previous office action as having been present in Lambert. Applicant's argument that an

element is not present in Lambert because it is not explicitly disclosed in the webpages

cited as Superpages is not persuasive. As noted in the previous office action, the

disclosure of Lambert is significantly more detailed than that of Superpages. The

reason for citing Lambert was due to its more comprehensive disclosure. In is noted as

well that applicant directs his remarks only to figures 16-17 of the Lambert reference

although a larger portion of the reference was cited. In addition, although the examiner

cites particular pages and paragraphs or columns and line numbers in the references as

applied to the claims for the convenience of the applicant, other passages and figures

may apply as well. Although the specified citations are representative of the teachings

in the art and are applied to the specific limitations within the claims, it is respectfully

requested that in preparing responses the applicant fully consider the references in

entirety as potentially teaching all or part of the claimed invention, as well as the context

of the passage as taught by the prior art or disclosed by the examiner.

Finally, the examiner notes an important difference between the language in the

claims and the paraphrased language in the applicant's remarks. The language

claimed, "calculates a customized price quote based on features to be included in the

customer's customized business listing," is broader than the argued, "customized price

quote that is calculated for the particular business listing configured and ordered by the

customer." The examiner believes the combined invention of Superpages and Lambert

(particularly Lambert) disclose both versions. In response to applicant's argument that

the references fail to show certain features of applicant's invention, however, it is noted

that the features upon which applicant relies (i.e., "customized price quote that is

calculated for the particular business listing configured and ordered by the customer.")

are not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In*

re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Pertaining to rejection of claim 16

With regard to claim 16, it should be noted that applicant argues that the prior art

does not disclose, "displaying at the Web site a solicitation for billing information from

the customer; and receiving billing information from the customer via the Web site." The

prior art displays a solicitation for and receiving of information identifying the customer.

Applicant argues that the information is merely contact information rather than billing

information. A comparison of the information fields in the reference (see at least V3 p.1)

with those in the present application's Figure 11 shows that the fields are virtually

identical. The information in the prior art would also ultimately be used for billing

purposes. Applicant argues that the two types of information "are not necessarily the

same." The continuing discussion regarding whether the information is exactly the

same or slightly different makes very clear that the essential nature of the information

has no functional bearing on the steps performed in the method. The customer's

identifying information, whether it is called contact information or billing information, is

descriptive material and is not functionally involved in the recited steps of the method.

Because it has no functional role in the method it is non-functional descriptive material.

This descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability, see In re Gulack, 703 F.2d 1381 , 1385, 217 USPQ 401, 404

(Fed. Cir. 1983). MPEP 2106).

Applicant argues that the difference between the two types of information "has a

direct and important functional bearing on the steps performed." A reading of the claims

shows otherwise. The relevant features claimed are, essentially, displaying a

solicitation for information, and receiving the information. These functions are not

influenced by the description of the information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.   **Claims 1-2,4,6-16,19-30,32,34-44,47-58,60,62-72, and 75-85 are rejected**

under 35 U.S.C. 103(a) as being unpatentable over Superpages (a collection of

prior art cited in Paper # 050715, PTO-892, Items U1-X7; See MPEP §2131.01) in

view of Lamburt (Paper #20061105; US Patent No.6,374,241).

Superpages teaches a method for providing a Web site accessible by a customer

and receiving an order request from the customer via the Web site to place an order for

a customized business listing in a business directory including at least one optional

listing enhancement requested by the customer (see at least U1 pp.1-2, V3 pp. 1-2, and

U6 p.1; Please note: V3 and U6 show that these features are inherent in U1. Please

note that throughout this Non-Final Office Action, Items W1-X7, when cited, are used to

show the inherency of each element in Items U1 and V1. Items U1 and V1 are versions

of the same homepage differing only in the date on which they were recorded. Items

W1-X7 are more detailed sub pages accessible through the homepage. V1 is a more

complete copy of the homepage, and its early date shows that the functional elements

detailed in items W1-X7 were present as of June 28, 2001, however, because not all of

the webpages shown as items W1-X7 are dated prior to June 28, 2001, Item U1 is

being used to show the total state of the enabled business directory website at least as

early as its date, July 20, 2002, the latest date of all the reference materials listed on the

form PTO-892 included herewith). Superpages further discloses:

- <u>displaying at the Web site a list of available optional listing enhancements</u> and

  receiving an enhancement request from the customer via the Web site to include

  in the listing of the business in the business directory at least one optional listing

  enhancement from the list of available optional listing enhancements whereby

  the customer configures a customized business listing (see at least U1 pp.1-2,

  V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2);

  receiving a request from the customer at the Web site to place the order for the

  listing of a business in a business directory including the at least one optional

  listing enhancement requested by the customer (see at least U1 pp.1-2, V2 pp.1-

  2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2).

- the business directory is a classified business directory (see at least U1 pp.1-2, V1 pp.1-2, W1 p.1, and X5 pp.1-2).

- displaying to the customer at the Web site a solicitation to enhance the listing with at least one optional listing enhancement, wherein the at least one optional listing enhancement can be purchased with an associated fee (see at least U1 pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2); receiving listing information from the customer at the Web site, wherein the listing information includes basic business information (see at least U1 pp.1-2, W3 p.1-4, X3 p.1).

- receiving listing information from the customer at the Web site, the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: basic business information including a business name, a business address, and a business telephone number, business market information including a region or market in which the customer wishes the business listing to appear, business category information including at least one business category under which the customer wishes to list the business in the business directory, also providing for at least two categories under which the customer wishes to list the business in the business directory; displaying at the Web site a list of available business categories and subcategories and receiving from the customer at the Web site a selection of a business category and subcategory from the list of available

business categories and subcategories (see at least U1 pp.1-2, X1 p. 1-2, U2

pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, X3 p.1, U3 p.1, W3 pp.1-4, U4 pp.1-2,

W4 pp.1-2, X4 pp.1-2, V5 pp.1-6, W6 p.1).

- receiving listing information from the customer at the Web site, the listing

  information including at least one of business market information, business

  category information and optional listing enhancement information relating to the

  placement and/or appearance of the listing in the business directory: including

  optional listing enhancement information that includes graphical and/or textual

  indicia the customer wishes to appear on the listing in the business directory, the

  graphical and/or textual indicia including at least one of a customer Web site link,

  a customer email link, enhanced text, listing highlighting, and a link to a

  supplemental listing, including a link to an enhanced listing, further including

  receiving supplemental information from the customer at the Web site that the

  customer wishes to be displayed when the link to the supplemental listing is

  accessed by a directory user; and also including receiving enhanced text

  information from the customer at the Web site that the customer wishes to

  appear on the listing in the business directory (see at least U1 pp.1-2, U2 pp.1-2,

  V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, X3 p.1, X4 pp.1-2, V5 pp.1-

  6).

- displaying at the web site a solicitation for billing information from the customer:

  receiving billing information from the customer at the Web site (see at least U1

  pp.1-2, V3 pp. 1-2. Please note: The customer's identifying information, whether

it is called contact information or billing information, is descriptive material and is

not functionally involved in the recited steps of the method. Because it has no

functional role in the method it is non-functional descriptive material. This

descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability, see In re Gulack, 703 F.2d 1381 , 1385, 217 USPQ 401,

404 (Fed. Cir. 1983). MPEP 2106).

- generating a price quote for the business listing ordered by the customer and

  displaying the price quote to the customer at the Web site; calculating the price

  quote based on features requested by the customer to be included in the

  business listing (see at least U1 pp.1-2, U2 pp.1-2, V2 pp.1-2, U3 p.1, W4 p.1-2).

- displaying a statement of terms and conditions to the customer at the Web site

  and receiving confirmation of acceptance of the terms and conditions from the

  customer at the Web site (see at least U1 pp.1-2, V5 pp.1-6, W5 pp.1-6, X6 pp.1-

  4, U7 pp.1-6, W7 pp.1-3).

- generating an order confirmation and displaying it to the customer at the Web

  site (see at least U1 pp.1-2, X3 p.1, Please note: it is an inherent aspect of the

  "Buy Ads Online" option and the option to see how the listing appears that the

  order confirmation would then be displayed to the customer, at least in the form

  of showing the customer's listing).

- the order serving to provide enhancements to an existing business listing in the

  business directory (see at least U1 pp.1-2, W3 pp.1-4, X3 p.1, V4 pp.1-2, U6 p.1,

  V7 p.1, X7 p.1).

- <u>business directory is an online business directory</u> (see at least U1 pp.1-2).

- <u>sending the customer an email</u> including information regarding the order for the

  listing in the business directory (see at least U1 pp.1-2, V3 pp.1-2).

Superpages teaches all the above as noted. Superpages teaches a) providing a

business directory, b) soliciting orders for listings in a business directory, c) providing a

website accessible by customers, d) displaying listing options and enhancements

available to customers for enhancing their business listings, and e) displaying price

quotes for customized business listings. Superpages however does not disclose

displaying multiple individually selectable optional listing enhancements, soliciting at the

website a selection by the customer of one or more of the optional listing

enhancements, generating a customized price quote for the customized business

listing, and displaying the customized price quote for the customized business listing at

the website to the customer. Lamburt teaches a) providing a business directory, b)

soliciting orders for listings in a business directory, c) providing a website accessible by

customers, d) displaying listing options and enhancements available to customers for

enhancing their business listings, and e) displaying price quotes for customized

business listings. Lambert further teaches displaying multiple individually selectable

optional listing enhancements, soliciting at the website a selection by the customer of

one or more of the optional listing enhancements, generating a customized price quote

for the customized business listing, and displaying the customized price quote for the

customized business listing at the website to the customer (see at least figs.16-22,

column 10 lines 45-53, column 54 lines 33-53. Please note: The figures indicate that

this reference is a US Patent drawn to the same invention previously evidenced by the non-patent literature Superpages or that they are both within the same family of inventions. Lambert however is a more thorough disclosure, showing and describing a greater degree of functionality than is evidenced by the archived webpages available in support of the previously cited Superpages reference.)

Pertaining to system Claims 29-30,32,34-44, and 46-56

Rejection of Claims 29-30,32,34-44, and 46-56 is based on the same rationale as noted above (Please note: the means for accomplishing each step of the method, as disclosed in the Superpages and Lamburt references noted above, is either disclosed or inherent in each specific section of the reference that discloses the step in the method. For example, the means for receiving a request from the customer at the Web site to place the order for the listing of the business in the business directory is disclosed in Superpages (see at least U1 pp.1-2, V3 pp. 1-2, and U6 p.1) in the form of the webpages themselves, while the means for displaying to the customer at the Web site a solicitation to enhance the listing with at least one optional listing enhancement, wherein the at least one optional listing enhancement can be purchased with an associated fee is inherent in the webpages disclosed in Superpages (see at least U1 pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2) because they must be displayed to the customer in order to achieve their essential function.

Pertaining to computer program product Claims 57-58,60,62-72, and 74-84

Rejection of Claims 57-58,60,62-72, and 74-84 is based on the same rationale as noted above (Please note: the computer program product and computer readable storage medium having computer readable program code embodied in the medium configured to accomplish each step of the method, as disclosed in the Superpages and Lamburt references noted above, is inherent in each specific section of the reference that discloses the step in the method. For example, the computer program product for receiving an order for a listing of a business in a business directory comprising a computer readable storage medium having computer readable program code embodied in the medium, the computer readable program code comprising computer readable program code configured to provide a Web site accessible by a customer, and computer readable program code configured to receive a request from the customer at the Web site to place the order for the listing of the business in the business directory is inherent in the webpages and method steps disclosed in Superpages (see at least U1 pp.1-2, V3 pp. 1-2, and U6 p.1) because without those elements the webpages could not exist.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the
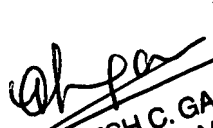
shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Adam Levine whose telephone number is 571.272.8122.

The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Adam Levine
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August 6, 2007